

REMARKS

Presently, Claims 51 and 68 are amended and Claims 69-90 are added. Claims 1-50, 52, 58, and 61-66 were previously cancelled. Accordingly, Claims 51, 53-57, 60, 67-90 are pending in this application.

Amendments to Claims 51 and 68 and added Claims 69-90 are supported in the specification, for example on pages 20-25.

Entry and consideration of the present amendments and remarks is respectfully requested.

Telephonic Interview

Applicants thank the Examiner for a helpful telephonic interview that took place on September 19, 2011.

Claim Rejections Under 35 U.S.C. § 102(b) Over Plehiers

Claims 51, 55, and 68 were rejected in the Office Action under 35 U.S.C. § 102(b) as anticipated by PCT publication WO 2003/027124 ("Plehiers").

With respect to Claim 51, the Examiner stated in the Final Office Action that "Plehiers et al. teach hydrolysable paint compositions (page 1, lines 12-20) comprising a compound that is an organosilyl ester of a carboxylic acid wherein the carboxylic acid part of the ester is saturated at the alpha carbon" and that "[s]everal components in Plehiers et al. can be considered co-binders such as the other monomers and comonomers in the binders (page 8, lines 9-18)." Office Action at 2-3. The Examiner also stated that "Plehiers et al. teach an antifoulant." *Id.* at 3.

Applicants respectfully traverse this rejection. The compositions of Plehiers are different from the composition of Claim 51. For example, Plehiers does not disclose the organosilyl ester

saturated at the alpha carbon in a combination with a co-binder. Furthermore, Plehiers is not directed to compositions that include a marine biocide.

The claimed composition, which includes a co-binder, is not disclosed in Plehiers. The organosilyl ester saturated at the alpha carbon and cited by the Examiner is identified in Plehiers as an acyloxysilane of formula (II). Plehiers, page 4, lines 3-13. However, Plehiers does not disclose a combination of the acyloxysilane of formula (II) with a co-binder. Rather, Plehiers discloses that the acyloxysilane of formula (II) is reacted with an unsaturated carboxylic acid of formula (III) to obtain an organosilylated carboxylate monomer of formula (I). *Id.* at page 3, line 25 – page 4, line 20. Plehiers further discloses that it is the organosilylated carboxylate monomer of formula (I) which is polymerized with various other monomers. *Id.* at page 8, lines 9-12. Accordingly, the acyloxysilane of formula (II) is not described in Plehiers in a combination with monomers, which the Examiner views as co-binders.

Furthermore, Claim 51, as amended, is directed to a hydrolysable paint composition that includes a marine biocide. In contrast, Plehiers is not directed to paint compositions that include a marine biocide.

Accordingly, for all of the above reasons, Applicants respectfully present that Plehiers does not anticipate Claim 51 and withdrawal of this rejection is respectfully requested.

Claim 55 depends on Claim 51 and Applicants respectfully present that the anticipation rejection of Claim 55 over Plehiers does not apply for the same reasons as those discussed above with respect to Claim 51.

Furthermore, the above arguments are also applicable to the anticipation rejection of Claim 68 over Plehiers and withdrawal of this rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. § 102(b) Over Slater

Claims 51, 54 and 68 were rejected in the Office Action under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,331,074 (“Slater”).

With respect to Claim 51, the Examiner stated, *inter alia*, that “Slater et al. teach compositions comprising a compound that is an organosilyl ester of a carboxylic acid wherein the carboxylic acid part of the ester is saturated at the alpha carbon (column 6, lines 46-68).” Office Action at 2-3.

Applicants respectfully traverse this rejection. The hydrolysable paint composition of the presently amended Claim 51 differs from the compositions of Slater. For example, the hydrolysable paint composition of Claim 51 includes a marine biocide. Slater, on the other hand, is not directed to compositions that include a marine biocide. Accordingly, Slater cannot anticipate Claim 51 and withdrawal of this rejection is respectfully requested.

Claim 54 depends on Claim 51 and Applicants respectfully present that Claim 54 is not anticipated by Slater for the same reasons as those discussed above with respect to Claim 51.

Furthermore, the above arguments are also applicable to the anticipation rejection of Claim 68 over Slater and withdrawal of this rejection is respectfully requested.

Claim Rejection Under 35 U.S.C. § 103(a) Over Slater

Claims 53 is rejected under 35 U.S.C. § 103(a) as obvious over Slater.

The Examiner stated that “Slater et al. teach using mixtures of crosslinking agents (column 6, lines 44-45)” and that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to use a mixture of acyloxysilane crosslinking agents (column 6, lines 46-67) in the composition to provide crosslinking of the polymers.” Office Action at 4.

Applicants respectfully traverse this rejection. Claim 53 is dependent on the presently amended Claim 51 which is directed to compositions that include a marine biocide. Slater, on the other hand, teaches against the use of marine biocides. The effectiveness of the Slater composition lies in providing a non-stick or low energy surface. Slater describes the silicon rubber compositions of Slater as being advantageous over “conventional antifouling compositions containing marine biocides which are gradually leached from the paint” while “[t]he silicone rubber coatings rely on their low surface energy, rather than on biocides, to inhibit settlement of marine organisms.” Slater at col. 1, lines 16-28. The “conventional antifouling compositions” described by Slater include hydrolysable paint compositions which are rendered hydrolysable so that the biocide is leached out.

Thus, Slater teaches away from use of marine biocides. Even if one were to add a marine biocide to the compositions of Slater, such marine biocide would be locked into the cross-linked structure of Slater with no release mechanism.

Accordingly, for all of the above reasons, Slater does not suggest or motivate the composition of Claim 53 and withdrawal of the obviousness rejection of Claim 53 is respectfully requested.

Allowable Subject Matter

Applicants thank the Examiner for stating that Claims 56, 57, 60, and 67 are allowable over the prior art.


CONCLUSION

Applicants respectfully submit that the application is now in proper form for favorable consideration and allowance. The Examiner is invited to contact the undersigned attorney for Applicant to discuss any outstanding issues.

The Commissioner is authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 06-0923, under Order No. SGK-028.

Respectfully submitted for Applicants,

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